

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
	:	Examiner: JOYCE, William C.
GLAESENER, Pierre, ET AL.)	
	:	Group Art Unit: 3682
Application No.: 09/835,439)	
	:	Confirmation No.: 7938
Filed: April 17, 2001)	
	:	May 7, 2007
For: FLEXIBLE SHOE ASSEMBLY)	(Monday)
	:	

MAIL STOP APPEAL BRIEF -- PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Appellants herewith submit their Reply Brief on Appeal.

(1) REAL PARTY IN INTEREST

The real party in interest remains the assignee of the subject application:

Husky Injection Molding Systems, Ltd.
500 Queen Street South
Bolton, Ontario, Canada L7E 5S5

(2) RELATED APPEALS AND INTERFERENCES

None.

(3) STATUS OF CLAIMS

Claim 1 (Rejected)
Claims 2-6 (Withdrawn)
Claims 7-11 (Rejected)
Claim 12 (Withdrawn)
Claims 13-26 (Cancelled)
Claims 27-35 (Rejected)

(4) STATUS OF AMENDMENTS

No Amendment was filed after the February 21, 2006 final Office Action.

(5) SUMMARY OF THE CLAIMED SUBJECT MATTER

See Appellants Brief on Appeal.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants gratefully acknowledge that the rejection of Claims 1, 7, 27, 28, 30, 31, and 35 under 35 U.S.C. §102(b) as being anticipated by Faint (USP 4,759,452) has been withdrawn.

Still to be reviewed on appeal is the rejection of Claims 1, 7-11, and 27-34, and 35 under 35 U.S.C. §103(a) as being unpatentable over Schlereth (USP 5,176,454) in view of Osawa (USP 4,941,758).

(7) Claims Appendix

See Appellants' Brief on Appeal.

(8) Evidence Relied Upon

Schlereth and Osawa.

(9) ARGUMENT

Briefly, the Examiner has not made out a prima facie case of obviousness because the cited references (taken in combination) fail to render obvious the claimed combinations.

2. [the numbering from the Appeal Brief and Answer is retained herein for ease of review] Claims 1, 7-11, and 27-34, and 35 are not obvious over Schlereth in view of Osawa.

In his Answer, the Examiner again relies upon the unsupported allegation that "Schlereth can be positioned in any orientation, including an inverted orientation..." Respectfully, there is no teaching or suggestion in Schlereth that his structure can be inverted. Indeed, such would be counterintuitive to the person of ordinary skill in the art at the time since the Schlereth structure is for mounting very heavy components such as "a displaceable part of a machine tool" (Col. 4, lines 52). Even a brief glimpse at Fig. 5 of Schlereth reveals that the person of ordinary skill in the art would not believe that it could be successfully inverted. If a heavy machine tool component were bolted to upper surface of block 216, and the structure were inverted, all of the considerable weight would be borne by the few ball bearings riding between the guide rail 210 and the flanges 212. See also Fig. 6, where inversion of the structure would cause a severe bending moment about the guide rail 310. Clearly, such a modification would encourage catastrophic failure, and thus be something the ordinarily skilled artisan would not contemplate. For this reason alone, the Examiner's rejection should be reversed.

The proposed combination of Schlereth and Osawa fails to disclose or suggest at least the following.

2A. Claims 1, 7-11, and 27-33.

2A (i) The Examiner states in his Answer that the claimed "lower mounting surface configured to engage a complementary surface within said molding system and providing positioning and adjustment of said shoe assembly during installation", is met by the (inverted) support surface 20, which is purportedly "capable of engaging a complementary surface of a molding system." The Examiner, however, gives no weight to the structural limitation

"configured to ... provide[ing] positioning and adjustment of said shoe assembly during installation." The Examiner is not free to disregard structural features of claims, which include functional recitations. *See* MPEP § 2173.05(g), *citing In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). The language "configured to" clearly restricts the corresponding structure to that structure which is capable of performing the recited functions. Indeed, dictionary.com defines "configure" as: "to design or adapt to form a specific configuration or for some specific purpose: *The planes are being configured to hold more passengers in each row.*" The terms "configured to..." would clearly be understood by the person of ordinary skill in the art as a structural limitation. In the present claims, the functions which the structure is configured to perform are those of positioning and adjusting the shoe assembly during installation. Any surface capable of engaging Schlereth's flat support surface 20 would not "provide[ing] **positioning** and **adjustment** of said shoe assembly **during installation.**" Instead, any flat surface placed on Schlereth's flat support surface 20 would not be able to perform the claimed positioning and adjustment during installation, as called for in the claims. Contrast this to the present invention wherein the lower mounting surface has structural features which are **configured** perform the claimed functions upon installation. In the embodiment of Fig. 7 the body 12 has a lower mounting surface 60 which is configured in a semi-cylindrical shape so as to engage a correspondingly-shaped complementary surface within the molding system (see 134 in the Fig. 15 embodiment). Clearly, the complementary semi-cylindrical shapes aid in adjustment and registration of the shoe assembly **during installation**. The flat surface 20 of the body 16 of Schlereth, on the other hand, will not provide any "adjustment of said shoe assembly during installation." Flat surfaces will not position and adjust themselves during installation, as will the specially configured surfaces claimed in the present invention. That is why Schlereth must use

threaded bores 22 to clamp on a further structural element. Thus, the flat surface of Schlereth is not configured to provide adjustment during installation. Accordingly, Schlereth lacks the claimed "lower mounting surface configured to engage a complementary surface within said molding system and providing positioning and adjustment of said shoe assembly during installation."

In his Answer, the Examiner states that the mounting holes 22 of Schlereth may be used to provide positioning and adjustment "when fastened to a complementary member." But, it is the *configuration* of the lower mounting surface itself that provides for the positioning and adjustment upon installation, not the bore holes. This is clear from the claim language, and would be so-construed by the person of ordinary skill in the art at the time, given the teachings of the specification and drawings of the subject application.

2A (ii) In his Answer, the Examiner failed to respond to Appellants' argument that, if the "plurality of balls" in Schlereth is the "wearing surface" (or even the substituted wear surface of Osawa), then Schlereth has no force redirector which "redirects said force from a leading edge and a trailing edge of said upper wearing surface to a central area in said body." That is, the balls 211x and 211y of Schlereth are disposed inside the guide carriage 212, and thus *inside* the "body." Even if the wear surface of Osawa were disposed inside the body of Schlereth, there is no force that is applied to a leading edge or a trailing edge of an *upper wearing surface* which the force redirector shifts to a central area thereof. Therefore, with the claims read onto the structure of Schlereth, modified by Osawa as proposed by the Examiner, there is no "*upper wearing surface*" from which the leading and trailing edge forces can be redirected.

2A (iii) Even if the linear bearing structure of Osawa is inserted into the guide carriage 212 of Schlereth at the location of balls 211x and 211y, the Schlereth structure will still lack either an upper wearing surface (as noted in 2(ii) above) or a *force redirector*, for the reasons detailed above and in the Appeal Brief.

2B. Claim 34.

In his Answer, the Examiner did not specifically address Appellants arguments in paragraphs 2B (i) and (ii) of their Appeal Brief.

2C. Claim 35.

In his Answer, the Examiner did not specifically address Appellants arguments in paragraphs 2C (i) and (ii) of their Appeal Brief.

2C (iii) Appellants reiterate that there are no lengthwise-extending bore holes in Schlereth. In his Answer, the Examiner states that "the [final] Action notes the bores extend in a lengthwise direction, inasmuch as applicant has defined the lengthwise direction of the shoe assembly." Respectfully, the ordinarily skilled artisan could not construe the bore holes 22 of Schlereth for the lengthwise-extending fixation holes claimed. Again, dictionary.com defines "lengthwise" as: "running or extending in the direction of the length of a thing; 'the lengthwise dimension.'" The holes 22 of Schlereth clearly do not extend in the lengthwise direction through the lower support of the body, as claimed. Rather, these holes 22 clearly extend in a direction that is perpendicular to the lengthwise direction of the lower support. In fact, given the

Examiner's interpretation that the body includes the block 16 and the guide carriage 212, the bores of Schlereth do not extend **through** any such body.

Accordingly, the Examiner has failed to identify structures and/or functions in Schlereth and Osawa which correspond to the features of Claims 1, 7-11, and 27-34, and 35 noted above. Thus, Schlereth and Osawa are insufficient to support the obviousness rejection under 35 U.S.C. §103.

3. Motivation.

In his Answer, the Examiner faults Appellants argument that the person of ordinary skill in the art at the time would not replace the more efficient ball bearings with a less efficient wear plate "because certain applications may not require high efficiency, such as a low load application." However, both the subject application and Schlereth are directed to **high load** applications. Thus, the person of skill in the art to which this invention is directed would never think to replace more efficient ball bearings with a less efficient wear plate (which would require much more power to move the equipment, due to increased friction). Schlereth's detailed discussion of wheels and the ball bearings would actually teach the person of skill in the high load arts away from the claimed wear plate. Likewise, nothing in Osawa suggests that more efficient ball bearings should be replaced with a less efficient wear plate. Thus, the person of ordinary skill in the art, at the time of the invention, would not be motivated to place the Osawa wear plate in the Schlereth structure.

Moreover, the suggestion to combine references must be more specific. The law is clear that the Examiner must make "findings as to the **specific** understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention

to make the combination in the manner claimed." (emphasis added) *In re Kotzab*, 217 F. 3d 1365, 1371 (Fed. Cir. 2000) (not overturned by the recent *KSR International Co. v. Teleflex Inc, et al.* Supreme Court decision No. 04-1550 (April 30, 2007)). The stated motivation-to-combine stated in the Answer ("reduce costs and assembly time") could be applied to any reference to render obvious any invention. This is woefully inadequate as a *specific* understanding that would have motivated one with no knowledge of the subject invention *to make the combination in the manner claimed.* Thus, a *prima facie* case of obviousness has not been made out, and this rejection must be withdrawn.

For all of the reasons noted above, Claims 1, 7-11, and 27-34, and 35 are fully patentable over Schlereth in view of Osawa.

CONCLUSION

In view of the above, Appellants submit that Claims 1, 7-11, and 27-34, and 35 are not obvious over Schlereth in view of Osawa. Accordingly, reversal of the final rejections, allowance of the rejected claims, and issuance of the subject patent application are respectfully requested.

Appellants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3507. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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